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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,257	07/23/2004	Satoshi Ohtsuka	2004-1070A	3941

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EXAMINER

MAI, NGOCLAN THI

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/502,257

Applicant(s)

OHTSUKA ET AL.

Examiner

Ngoclan T. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/23/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lambard et al.

Lambard et al disclose a martensitic alloy based on iron and chromium strengthened by a dispersion of oxides comprising about 7 to about 12% by weight of chromium, from about 0.5 to about 3.0% by weight tungsten, from about 0.02 to about 0.2% by weight carbon, from about 0.02 to about 0.3% by weight oxygen, up to about 1% by weight yttrium, up to about 1.0% by weight Ti and the remainder being iron. The martensitic alloy is formed by mechanical alloying starting powder that has a composition corresponds to that of the manufactured blank and oxides such as Y_2O_3 in neutral atmosphere such as argon. Lambard et al also teaches employing yttrium powder in the starting powder, col. 3, lines 56-59.

While Lambard et al does not specifically teach adjusting the Ti content within the range of 0.1 to 1.0% so that an excess of oxygen content in the steel satisfies the claimed formula, however when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new

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products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the references). Overlapping ranges have been held to be a prima facie case of obviousness. See In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lambard et al in view of Taguchi et al.

Lambard et al discloses the method for making oxide dispersion strengthened martensitic steel substantially as claimed. The difference between the claim and the Lambard et al is that Lambard et al does not teach mechanically alloying the starting powder and oxide in an Ar gas having a purity of not less than 99.9999%.

Taguchi et al teaches that the presences of free O, C and N introduced during mechanical pulverizing affect particle boundaries of starting powder which cause embrittlement of the materials. See Taguchi et al., col. 4, lines 23-31. Taguchi et al also teach to suppress the inclusion of these materials, a high purity inert gas can be used, col. 4, lines 32-37. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a high-purity argon atmosphere during the

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mechanical alloying the powder taught by Lambard to avoid the presences of free O, C and N. Determination of an optimum or preferred purity of argon utilized to effectively suppress the inclusion of these material is with in the level of one skilled in the art.

“[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable range by routine experimentation.”

See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d (Fed.cir), cert. denied, 493 U.S. 975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).


4. Claim 3 is free of the cited prior art because there is no teaching or suggestion in the prior to suppress the formation of oxygen during mechanical alloying by reducing or decreasing the stirring energy.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ngoctan T. Mai
Primary Examiner
Art Unit 1742

n.m